

*Draft revision for 4-12-16 Senate*

Key to changes:

Black = Text that remains the same as P09-03

Green = New text inserted into document, borrowed or revised, from CSU-Chico's Intellectual Property Policy

Blue= Text based on FAC, Administrator and SenEx feedback

## EXECUTIVE MEMORANDUM

May 2016

P16-

Supersedes P09-03

SUBJECT: INTELLECTUAL PROPERTY POLICY

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## I. GENERAL PURPOSE AND SCOPE

### **A. Purpose.**

The University is committed to providing an intellectual environment in which all members of the academic community – whether they are faculty engaged in life-long professional development, students pursuing educational objectives, or staff dedicated to their own career goals – learn to the fullest extent possible. The University also recognizes and values creativity and innovation as part of the learning process. Similarly, the University recognizes the importance of, and wishes to encourage, the transfer of new knowledge, generated in the University, to the private sector for the public good. At the same time, as a publicly funded institution, the University must be a good steward of the public resources provided to it, and must safeguard against the use of public funds for private gain.

### **B. Scope.**

This policy addresses the rights to, interest in, and protection and transfer of intellectual property created by University faculty, staff and students. Issues not directly considered in this policy, including disagreements concerning its application or interpretation, will be addressed and resolved through [the Advisory Board for Research and Creative Projects](#) consistent with applicable law and collective bargaining agreements. In the event of a conflict between this policy and the collective bargaining agreements, the bargaining agreements shall prevail. Policies affecting the use of the University's names or symbols are not addressed in this document.

### **C. Governing Principles.**

The following principles underlie this policy and should guide its application and interpretation:

- 1. Academic Freedom and Preeminence of Scholarly Activities.** The missions of teaching and scholarship have preeminence over that of the transfer and commercialization of research results. The University's commitment to its educational mission is primary, and this policy does not diminish the right and obligation of faculty members to disseminate the results of research and creative activity for scholarly purposes.
- 2. Equity and Fair Play.** This policy sets forth general principles and procedures, and it has not been designed to address every conceivable circumstance. Under principles of fair play, the inventor(s)/creator(s) and the University mutually operate so that no one will unfairly exploit inadvertent errors or omissions in this written policy. If the need for a correction and/or exception to this policy is identified, appropriate recommendations shall be made to the President through the [Advisory Board for Research and Creative Projects](#).
- 3. Mutual Trust and Goodwill.** Throughout all phases of the creation and implementation of this policy, it is assumed that all members of the University community will be guided by a sense of mutual trust and goodwill. In the event of future controversies regarding the rights to intellectual property, the commercialization of particular property, or in the interpretation of this policy, all parties should recognize that mutual trust and goodwill were fundamental tenets in the forging of this policy.

**4. Faculty Governance and Review.** University faculty, through the Advisory Board for Research and Creative Projects (see III.A.2), shall play a primary role in the establishment and periodic revision of this policy, and in the review and recommendation of resolutions to disputes arising under it. This committee shall have a majority of members who are faculty without administrative appointments.

**5. Transparency.** The principle of openness promotes both the disclosure and avoidance of actual and apparent conflicts of interest associated with external commercial activities.

**6. Reasonableness in Licensing.** When the University owns intellectual property under this policy, the inventor or creator shall normally play an active role in the entire licensing process, including consultation and/or approval of licensing decisions, particularly where the inventor/creator has no financial interest in the licensee. Otherwise, such participation shall be consistent with conflict of interest regulations or University policy.

**7. Extraordinary University Support.** It will be presumed that extraordinary support has not occurred in the absence of a written agreement between the University and the particular creator(s) or inventor(s) that acknowledges the provision of extraordinary support.

#### **D. Policy Application.**

This policy takes effect immediately and supersedes all prior intellectual property policies.

#### **E. Key Terms.**

For purposes of this policy, the following key terms are defined as follows:

- 1. “Auxiliary Organization”** means any nonprofit organization affiliated with the University and recognized in good standing by the CSU Chancellor. This includes the Sponsored Programs Foundation, [University Advancement](#), and Associated Students.
- 2. “Copyright”** is a bundle of property rights that legally protect the owner(s) from others copying, distributing, otherwise communicating or making substantive derivative works from copyrighted works which are “original works of authorship fixed in a tangible medium of expression” (from U.S. copyright law) without the permission of the owner(s). “Tangible media” include, but are not limited to, books, periodicals, manuscripts, phono-records, electronic recordings, web based materials, films, tapes, and works of art. The doctrine of “fair use” does allow for some use of an unsubstantial portion of the copyrighted material without the creator(s)’ permission. Copyrighted work may include literary works; musical works, including any accompanying words; pantomimes and choreographic works; pictorial, graphic, and sculptural works (photographs, prints, diagrams, models and technical drawings); motion pictures and other audiovisual works; sound recordings; computer software (may be patented as well) and architectural works.
- 3. “Disclosure Statement” aka “Disclosure”** means a written general description of an invention, discovery or innovation by the creator used to help assess the nature, extent and likely intellectual property interests in and development potential of the invention, discovery or innovation.

4. **“Equity interest”** refers to beneficial rights (such as royalties) derived from intellectual property owned by another.

5. **“Extraordinary University Support”** generally means resources not usually available to all members of the University community in a similar employment or other classification or otherwise obvious by the individual’s job description and duties. Extraordinary support is demonstrated through a separate, individual work for hire agreement between the University and the member of the University Community.

a. For faculty, extraordinary support does not include such resources as academic year salary, office space and office furniture and equipment, including a personal computer, usual services of University support staff including technology support from ITS, common library resources, usual laboratory space and equipment and its common usage unless the intent of providing such resources is specifically to support the development of intellectual property for acquisition by the University. Consistent with section I.C.7. of this policy, all cases in which the University claims it is providing or has provided extraordinary support must be acknowledged in a written agreement signed by the appropriate University administrator and the faculty member in which receipt of extraordinary support is acknowledged.

In addition to the foregoing, absent a written agreement acknowledging receipt of University extraordinary support, the following resources do not, in and of themselves, constitute forms of extraordinary support:

- Mini-grants such as CSU Research, Scholarly, and Creative Activities, Faculty Development awards, Diversity Development awards, and Incentives Funding.
- eLearning instructional support eLearning Course Development Grants. It is understood that online teaching has become a part of a faculty member’s expected workload and that use of any equipment such as laptops or tablets, or acceptance of any stipends or assigned time to prepare a face-to-face course or new course for on-line delivery do not automatically constitute provision of extraordinary support.
- Sabbatical or difference-in-pay leaves.
- Startup funds or startup assigned time
- Advising/academic program Chair assigned time.

b. For staff, most work resulting in intellectual property is considered within the scope of the job duties of the individual unless there is a written agreement to the contrary. Therefore, the usual situation for staff employees is that creations or inventions that may result from an individual’s work does not result from extraordinary university support and, thus, is work for hire. Some exceptions to this general situation may result which the staff employee should bring to the attention of appropriate individuals to insure agreement about intellectual property rights and ownership.

c. For students, extraordinary university support means the use of resources that are not available to the majority of University students in the course of their academic programs.

6. **“Faculty”** primarily means members of Collective Bargaining Unit 3. Under certain circumstances faculty may also include visiting professors, volunteer professors, adjunct professors and other individuals who may temporarily carry out research and creative activities in a capacity other than staff or student.

7. **“Intellectual Property”** is unique, tangible products brought about through the creative endeavors of human beings. These products can be protected by a variety of legal means including those embodied in such mechanisms as copyrights, patents, trade secrets, know-how and other proprietary concepts. In most cases, to use intellectual property one must be the owner of the property or have permission from the owner by obtaining a license or a legitimately procured original or copy of the property.

8. **“Inventions, discoveries, or innovations”** include tangible or intangible inventions, whether or not reduced to practice and tangible research products whether or not copyrightable or patentable. Such research products include, for example, computer software/programs, integrated circuit designs, industrial designs, databases, technical drawings, biological materials and other technical creations.

9. **“License”** is an agreement by one party, usually the owner of intellectual property, to another party to use the intellectual property for some purpose, commercial or otherwise, with terms and conditions as to the use. Compensation often is part of the licensing agreement.

10. **“Materials Transfer Agreement”** is a contract that grants the limited use of one party’s material to another for research and educational purposes but not for commercial purposes. No ownership rights are transferred nor any right to commercial use.

11. **“Members of the University Community”**, as used in this policy, means faculty, staff, students, auxiliary organization employees and contractors.

12. **“Net proceeds or income”** means the net amount received in the form of royalties or other fees related to licensing or selling intellectual property in any fiscal year after deduction of all accrued costs reasonably attributable to such intellectual property. Although this list is not exhaustive, such costs may include patent or other intellectual property prosecution, protection or litigation, and commercialization. Specific items of costs may include legal filing fees, patent application costs, insurance and maintenance charges, transfer and licensing costs and product development costs.

13. **“Non-Disclosure Agreement”** is a contract to maintain the confidentiality of specified information. Such an agreement limits the receiving party’s rights to disclose the information to others for any purpose.

14. **“Owner”** is a person(s) or organization(s) that has a property title to intellectual property. An owner of intellectual property may be a creator, author or inventor of the intellectual property, an organization employing the creator, author or inventor, or a person or organization that has obtained title from the owner(s). Intellectual property owners have the right to restrict others from using the intellectual property, may license its use to others or may outright sell or assign all or part of the rights to others. Full or partial ownership can be transferred or shared among various individuals and/or organizations.

15. **“Patent”** is a bundle of property rights giving the owner(s) the right to exclude others from making, using or selling an invention for a specific period of time. Patents can be granted by the U.S. Patent and Trademark Office for inventions or discoveries which constitute any new and

useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof; new and ornamental designs for any useful article and plant patents for the asexual reproduction of any new and distinct variety of plant.

16. “**Royalties**” mean payments made, based usually on a license agreement, for the use of intellectual property.

17. “**Software**” means computer instructions (algorithms, source, and object codes), data and accompanying documentation.

18. “**Sponsor**” means any external individual or entity, whether public or private, that enters into a formal agreement or awards a grant with or to the University or an auxiliary organization of the University (such as the Sponsored Programs Foundation), whereby the sponsor provides support for a project to be carried out by faculty, staff and/or students of the University community.

19. “**Staff**” means all non-faculty employees of the University or one of its auxiliary organizations.

20. “**Student**” means any individual enrolled in the University, or working in a student capacity under the auspices of the University or an auxiliary organization.

21. “**Trade Secret**” and/or “**Proprietary Information**” involve confidential information that may give someone or some entity a competitive advantage. Such information can include an unpatented invention, a formula, a method, a process, a customer list, plans, financial data, etc. Generally, as long as such information is kept secret, it can be licensed to others. Once it is disclosed or discovered, the secret is considered destroyed and, therefore, no longer protected intellectual property.

22. “**University**” means Humboldt State University and associated self-support organizations, such as Extended Education.

23. “**Work for Hire**” is a legal concept whereby work created by an employee, absent any other agreements to the contrary, becomes the intellectual property of the employer at the time of the work’s creation or invention.<sup>1</sup>

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<sup>1</sup> In the academic context, federal case law indicates that much of the work faculty do, such as write scholarly articles or create new course materials, can be excluded from “work for hire”, whereas work done by staff in their regular capacity as an employee, is typically included as “work for hire”. (See American Association of University Professors, “Defending the Freedom to Innovate: Faculty Intellectual Property Rights after Stanford v. Roche” (2015). Access at: <http://www.aaup.org/report/defending-freedom-innovate-faculty-intellectual-property-rights-after-stanford-v-roche>). Article 39 of the collective bargaining agreement between the California Faculty Association and the CSU, concerns intellectual property that is the result of what is determined by the CFA and the CSU to be faculty “work for hire”. When faculty seek to clarify or contest University claims to intellectual property created as the result of what may be considered to be work for hire, they should contact the California Faculty Association.

## II. OWNERSHIP AND OTHER INTEREST

### A. General

#### **1. Intellectual property created without University resources**

The University recognizes the right of members of the University community to create intellectual property on their own time and with non-University/auxiliary organization resources. In such cases, the employee shall have sole ownership of such property and any proceeds derived from it.

#### **2. Sponsored funding**

When the University or one of its auxiliary organizations receives funding from a sponsor, the funding agreement typically contains terms and conditions that grant some or all of the intellectual property rights that may result from the project to the awarding entity, a third party, and/or the University/auxiliary organization. The terms and conditions of any funding agreement (e.g., grant or contract), from an external sponsor will be paramount in determining intellectual property ownership, obligations, and other rights (including sharing net proceeds) that may accrue as a result. The Dean of the Office of Research, Economic and Community Development has the final authority to negotiate and accept all sponsor agreements, including materials transfer agreements. The Dean of the Office of Research, Economic and Community Development has the final authority to negotiate and agree to terms and conditions concerning intellectual property, including materials transfer agreements, in the form of sub-agreements to individuals and entities external to the University that may conduct a portion of the project or work under a special intellectual property agreement. In doing so, the Dean of the Office of Research, Economic and Community Development will see input from the project director and the dean of his/her college.

Following the requirements of CSU Chancellor's Office Executive Order 890, the University and its auxiliary organizations will endeavor to do the following: Any sponsor agreement that provides for ownership or license of resulting project work products such as intellectual property to any person or entity other than the University or one of its auxiliary organizations shall provide the University with a free-of-cost, nonexclusive license to use the work product and any resulting intellectual property and the right to access and use the results (data, material(s), knowledge, etc.) for purposes consistent with the educational mission of the University at the originating campus only and not at other CSU campuses without consent and compensation consistent with normal licensing at non-CSU institutions. Where such limited rights cannot be obtained, the Dean of the Office of Research, Economic and Community Development, in consultation with the project director, will determine if the campus should proceed with accepting the award due to other benefits outweigh obtaining the limited rights set forth in E.O. 890.

#### **3. Written agreements**

Whenever possible, written agreements about intellectual property ownership, other rights and royalty sharing (net proceeds) shall be made prior to accepting an award or contract. This includes all contracts in which the University claims to be providing extraordinary support to a member of the University Community for purposes of establishing an intellectual property right. If it is not possible to establish terms in writing before the contract or award is accepted by the faculty, staff or student, such agreement must be made before beginning the work expected to



lead to the creation of intellectual property. When such written agreements have not been made prior to the creation of the intellectual property, such a written document should be prepared immediately following the creation and disclosure as required by other provisions of this policy and any sponsor agreements.

## **B. Copyright**

### **1. Faculty Creations.**

a. Faculty own the intellectual property and any resulting copyrights that originate from normal faculty bargaining unit work and work through extended degree programs (those University entities governed by EO 1099), namely instructional, scholarly and creative works each individual creates. These include such works as syllabi, learning modules, tests and quizzes, course content (assignment materials in any medium, lectures, websites, etc.), online instructional materials, scholarly publications and presentations, works of art (including musical scores and recordings, video works, various mediums of visual arts like paintings, prints, sculpture, pottery, photography, dance choreography and the like). Faculty retain the right to use these learning materials for profit through other institutions both while employed by the CSU and after separation.

Faculty may voluntarily share their copyrighted intellectual property with other instructors or the University (including their home departments). A faculty member may withdraw his/her intellectual property from circulation at the conclusion of each semester by providing written notice to their department chair or immediate supervising administrator (typically the Dean of the College). If a faculty member agrees to share materials with another instructor or with the University, that faculty member cannot revoke the permission to use those materials within a semester if the materials are currently being used by another instructor or by the University.

b. If the University provides extraordinary support to a faculty member toward the creation of copyrightable property, the faculty will own the copyright but the University will be entitled to a license to use the property and an equity interest in the profits derived from any commercialization of the intellectual property, according to the provisions in section II. E. A written document, signed by the faculty member and the University, preferably prior to initiation of the project, will be executed to acknowledge the University's license and equity interest and the faculty member's commitment to cooperate with the University. This written agreement must specify the term (length of time) during which the University's interest extends and whether or not its interest extends to only original materials or future (new or revised) materials as well.

c. If the University initiates a creative project for purposes of developing intellectual property that the University plans to copyright, the University will own the intellectual property rights developed through the project unless the University agrees to share ownership. These projects may include faculty participation remunerated through faculty compensation/assigned time, but faculty may be restricted from a claim property rights over the product. A written document, signed by the faculty member and the University prior to initiation of the project, will be executed to acknowledge the University's ownership, or sharing arrangement, and the faculty member's commitment to cooperate with the University, at University expense, on the

project and to help commercialize the intellectual property. In this agreement, the University may opt to share with the faculty any net proceeds that result from the intellectual property created from the project.

Issues that arise with faculty-created copyrightable intellectual property that are not resolved through written agreement shall be referred to the Dean of the Office of Research, Economic and Community Development and the Advisory Board for Research and Creative Projects for further adjudication.

d. If the University/Sponsored Programs Foundation and an outside sponsor enter into an agreement to carry out research or other creative activity involving faculty, the faculty who participate in the project shall comply with the conditions of the agreement regarding ownership, protection and licensing of intellectual property developed under the agreement, and may be required to agree in writing that they will so comply. Copyright terms of such agreements will be negotiated with the sponsor by the Dean of Research, Economic and Community Development, with the consent of the faculty involved and the appropriate College Dean(s). In such circumstances copyright terms may deviate from the provisions of this policy.

## **2. Staff Creations.**

a. The University owns the copyright to works created by University staff in the course and scope of their employment.

b. Staff persons own the copyright to all works created by them without the use of University resources and developed outside the course and scope of their employment, and the University has no equity interest in any proceeds derived from them. If staff utilize University or auxiliary resources to develop works outside of the scope of their employment, the University or auxiliary organization will be entitled to an equity interest in the royalties or sale proceeds derived from the commercialization of the intellectual property. Staff persons are advised to notify the their union representatives and/or Human Resources staff about their external activities if they have concerns that the University might claim ownership interests in any intellectual property resulting from those activities.

c. The University or Sponsored Programs Foundation (SPF) may employ or engage individuals under specific contractual terms that allocate copyright ownership rights between the parties in a different manner than specified above. Such agreement(s) shall supersede this policy to the extent that any provisions are in conflict.

d. There may be occasions when University staff also serve as faculty for the University. Under these circumstances, written agreements should be entered into in advance of undertaking any research or creative activity to clarify whether the individual is acting in their staff or faculty capacity in carrying out the activity. Unresolved questions on ownership may be directed to the Advisory Board for Research and Creative Projects and a recommendation regarding ownership rights will be made to the President. Such agreement(s) shall supersede this policy to the extent that any provisions are in conflict.

## **3. Student Creations.**

a. Students will normally own the copyright to the scholarly and creative publications they develop, including works fulfilling course requirements (term papers and projects), Senior or Capstone Projects, and Masters Theses/Projects. Students retain copyright ownership as long as they are not paid for the work that results in the creation and do not receive extraordinary University support toward the creation of the work. Nonetheless, by enrolling at the University, the student grants the University a nonexclusive, royalty-free license to modify, publicize and retain the work as may be agreed upon by the faculty, department, or the University. The University is not entitled to an equity interest in any proceeds (net or otherwise), except in the circumstances covered below.

b. When the student is employed by the University and the creation falls within the scope of that employment either the University or the faculty member (when the student is hired specifically to work on a faculty project) owns the copyright.

c. When the student receives extraordinary University support that furthers the creation and development of their creative work, then the student owns the copyright, but the University retains and equity interest in the work and any royalties earned from commercialization of the work according to the provisions of Section II.E. of this policy.

d. If the student works on a project subject to the terms of a sponsor's agreement (usually a grant or contract) or a special intellectual property agreement, and the creation falls within the scope of that work, then the student is bound by the written agreements governing the allocation of copyright ownership. Generally, absent an agreement to the contrary, any student paid work or internship on a project governed by a sponsor's agreement and/or special intellectual property agreement, student creations will be considered work for hire and ownership will be with the University or auxiliary organization that is employing the student.

## **C. Patents.**

### **1. Patentable intellectual property**

This section addresses the ownership of patentable intellectual property, including potentially patentable inventions, trade secrets or proprietary information, created by faculty, staff, and students. The University shall share royalties from inventions assigned to the University with the inventor(s). If the University cannot or decides not to proceed in a timely manner to patent and/or license an invention, it will reassign ownership to the inventors upon request to the extent possible under the terms of any agreements that support or are related to the work.

### **2. Disclosure**

A potentially patentable invention conceived or first reduced to practice in whole or in part by members of the faculty, staff and student employees of the University in the course of their University responsibilities or with extraordinary use of University support shall be disclosed on a timely basis to the University. Faculty who are working under a sponsored project, who have agreed to act in a work for hire situation, or who have used extraordinary University support that creates or leads to the development of non-copyrightable intellectual property must disclose such intellectual property to the Dean of Research, Economic and Community Development. Staff and student employees of the University, or one of its auxiliary organizations, who conceive of or first reduce to practice a potentially patentable invention or discovery, or develop other intellectual property that may be considered a trade secret or

proprietary information in the course of their job duties or as part of an externally funded project secured through a campus contract or grant, will disclose the discovering in a timely manner to the Dean of Research, Economic and Community Development. Ownership of such inventions shall be assigned to the University or appropriate auxiliary organizations except as noted in the following sections.

### **3. Faculty Inventions.**

Faculty own the intellectual property and any resulting patents that originate from normal faculty bargaining unit work, namely instructional, scholarly, and creative works each individual creates. Such works may also include inventions, discoveries, trade secrets or proprietary information, computer software programs and their underlying algorithms and codes, and such other intellectual property that does not fall clearly under what might be legally protected by copyright.

b. If the University provides extraordinary support to the creation of intellectual property, then the faculty will own the intellectual property rights, but the University will be entitled to an equity interest in the profits derived from the commercialization of the intellectual property, according to the provisions in section II.E.

c. If the University initiates a creative project, solicits voluntary faculty participation in the project, and provides funding for the project, including compensation/release time for the faculty member, the University will own the intellectual property rights developed through the project unless the University agrees to share ownership. A written document created through the Office of Research, Economic and Community Development signed by the faculty member prior to initiation of the project, will be executed to acknowledge the University's ownership, or sharing arrangement, and the faculty member's commitment to cooperate with the University, at University expense, to protect and commercialize the intellectual property. Should the parties agree, the University may opt to share with the faculty involved any profits that result from the intellectual property created on the project. Such agreement, and the details of profit-sharing arrangements, shall be recorded in a written document, signed by the faculty involved and the University's designee. If the agreement conflicts with portions of this policy, the parties must explicitly agree to supersede this policy.

d. If the University/Sponsored Programs Foundation and an outside sponsor enter into an agreement to carry out research or other creative activities involving faculty, the faculty who participate in the project shall comply with the conditions of the agreement pertaining to the ownership, protection and licensing of intellectual property developed, and may be required to agree in writing that they will so comply. The intellectual property terms of such agreements, will be negotiated with the sponsor by the Dean of Research, Economic and Community Development, with the consent of the faculty involved and the appropriate College Dean(s). Any agreements about ownership of intellectual property, and the details of profit-sharing arrangements, shall be recorded in a written document, signed by the faculty involved, the outside sponsor and the University's designee. If the agreement conflicts with portions of this policy, the parties must explicitly agree to supersede this policy.

### **4. Staff Inventions.**

a. The University shall own all intellectual property rights in works created by University staff in the course and scope of their employment.

b. The University has no equity interest in any proceeds derived from intellectual property that is created by staff without the use of University resources and that is developed outside the course and scope of employment. **If staff utilize University or auxiliary resources to develop intellectual property outside the scope of their employment, the University or auxiliary organization will be entitled to an equity interest in the royalties or sale proceeds derived from the commercialization of the intellectual property.** Staff persons are advised to notify **their union representatives and/or Human Resources staff** about their external activities if they have concerns that the University might claim ownership interests in any intellectual property that results from those activities.

c. The University or **Sponsored Programs** Foundation may employ or engage individuals under specific contractual terms that allocate intellectual property rights between the parties in a different manner than specified above.

d. There may be occasions when University staff also serve as faculty for the University. Under these circumstances, written agreements should be entered into in advance of undertaking any research or creative activity to clarify whether the individual is acting in their staff or faculty capacity in carrying out the activity. Unresolved questions on ownership may be directed to the Advisory Board for Research and Creative Projects and a recommendation regarding ownership rights will be made to the President. Such agreement(s) shall supersede this policy to the extent that any provisions conflict.

## **5. Student Inventions.**

Students enrolled at the University may create valuable intellectual property while fulfilling course requirements, in conjunction with University employment, and/or through the use of University resources. The ownership interests in such intellectual property depend on the particular circumstances surrounding the creation. In particular, students must be careful to differentiate their own creative contributions from those of their faculty instructors and mentors. The following parameters apply:

a. **Students in most instances will own the intellectual property developed from their individual scholarly and creative works, including works fulfilling course and academic program requirements (term papers, projects, masters theses/projects). Students retain ownership as long as they are not paid for the work that results in the creation and do not receive extraordinary University support toward the creation of the work. Nonetheless, by enrolling in the University, the student grants the University a nonexclusive, royalty-free license to mark on, modify, publicize and retain the work as may be required by the faculty, academic department or University. The University is not entitled to an equity interest in any ownership proceeds (net or otherwise), except in the circumstances described below.**

b. **When the student is employed by the University and the creation falls within the scope of that employment, either the University or the faculty member (when the student is hired specifically to work on a faculty-conducted project) owns the intellectual property according to the same standards that apply to staff creations under section II.C.4.**

c. When the student receives extraordinary University support that further the creation or development of the intellectual property, the student owns the intellectual property, but the University retains an equity interest.

d. When the student works on a sponsored project or under a special intellectual property agreement and the creation falls within the scope of that work, then the student is bound by the written agreements governing the allocation of intellectual property rights.

e. When the student is employed by an outside entity (not the University or Sponsored Programs Foundation) and the creation falls within the scope of that employment, the student normally will be bound by a contract with the outside entity, including provisions intended to protect and allocate intellectual property rights, and the University will have no rights to the intellectual property developed.

f. Unresolved issues of ownership and other intellectual property rights may be directed to the Advisory Board for Research and Creative Projects. The Dean of Students should be consulted on a case-by-case basis about appropriateness of using established student grievance procedures.

#### **D. Software.**

1. The proprietary protection available for software is unique in that both copyright and patent are available. Copyright protection may cover the expression of the software ideas in a tangible medium, while patent protection may cover algorithmic inventions. Due to this dual approach, software should first be considered under the patent provisions of this policy at II. C., and is therefore subject to disclosure of any underlying algorithms that appear to have commercial value. After consideration of patent protection for valuable software algorithms, copyright (see II.B.) should be considered as additional or alternative protection.

2. In accordance with section I.C.1, and absent a specific agreement to the contrary, the University favors the copyright and publication of source code as well as its underlying object code. (This is in contrast with the common commercial practice that utilizes trade secrecy for source code in order to prevent the dissemination and discussion of any innovative ideas it reveals.) As with the underlying algorithms that, if patented, must be published so that they may be studied and discussed by other researchers, the University believes that source code should be published in a form that is amenable to research and will promote scientific progress. The object code is similarly subject to copyright.

#### **E. University Equity Interests.**

If the University provides extraordinary support to the creation of intellectual properties, it enjoys an equity interest in the net proceeds derived from those properties. The University's equity interest is determined by the extent of use and the value of these extraordinary support. The amount of the University's equity interest in a particular intellectual property will be agreed upon in a written agreement before pursuing protection/commercialization. In no case will the University's share be greater than 50 percent. (The distribution of any monies garnered is detailed in Section IV.B.) When the amount of net proceeds received from an intellectual

property subject to University equity interest is equal to or less than \$25,000 in a fiscal year, then the University is not entitled to any portion of the net income derived from that intellectual property. When the amount of net proceeds received from an intellectual property subject to University equity interest is greater than \$25,000 in a fiscal year, the net proceeds (in excess of \$25,000) will be allocated as described in Section IV.B., or based on a previously determined equity interest agreement.

The University/[Sponsored Programs](#) Foundation is entitled to recoup expenditures from gross proceeds derived from those intellectual property interests that are successfully commercialized.

### III. ADMINISTRATIVE PROCEDURES

#### A. The University.

##### **1. University Administration.**

The University President is responsible for policy matters relating to intellectual property and affecting the University's relations with inventors and creators, public agencies, private research sponsors, industry, and the public. The Dean of [Research, Economic and Community Development](#), in cooperation with the [Sponsored Programs](#) Foundation and University officials, shall implement and administer this policy, including the [negotiation of intellectual property terms in agreements with sponsors, evaluation of patentability and other forms of intellectual property protection, negotiation of use rights \(licenses\) and royalties and pursuit of infringement actions.](#) The Dean of [Research, Economic and Community Development](#) in cooperation with the [Sponsored Programs](#) Foundation and University officials shall develop, document, implement and maintain on a current basis, appropriate procedures and practices to carry out this [policy](#), including the process for evaluating and determining the allocation of net proceeds derived from intellectual property, subject to Section IV. of this policy. The Dean of [Research, Economic and Community Development](#) shall consult with the [Advisory Board for Research and Creative Projects](#) (see III.A.2) on any significant procedural or policy changes associated with this policy. **All changes to this policy must be approved by the University Senate.**

##### **2. Advisory Board for Research and Creative Projects.**

The University President shall confirm through appointment by the University Senate, an [Advisory Board for Research and Creative Projects](#). The Board shall be composed of seven members, four of whom are faculty. One faculty member shall represent each college and the Chair of the Faculty Affairs Committee shall also serve. The other members shall include the Vice President for Academic Affairs (Provost) or his/her designee, the Associate Vice President for College of eLearning and Extended Education and the Dean of Office of Research, Economic and Community Development, who shall chair the committee. Faculty appointees will serve three-year terms.

The duties of the Board shall be:

- [To review implementation of current university intellectual property policy and develop changes to the policy as needed. All proposed changes must be approved by the University Senate.](#)

- To make recommendations for the allocation of the University's net proceeds from intellectual property.
- To help determine the University's contribution to the development of particular intellectual properties for purposes of helping parties reach an agreement within the framework of this policy (when the issues concerned are not covered by relevant collective bargaining agreements).
- To act as an appellate body, advisory to the President, in cases of disagreement concerning the application of this policy (when the issues concerned are not covered by relevant collective bargaining agreements).

In its deliberations the Board will rely on information provided by both the inventor/creator and the University and will maintain confidentiality regarding patented or copyrightable material. When a Board member is an interested party in a disagreement related to determining the University's contribution to the development of particular intellectual properties or about the application of this policy to a specific case, he/she must recuse him/herself from the deliberations and resulting recommendations of the Board. In cases in which the Board is unable to resolve disagreements to the satisfaction of the interested parties, then it shall submit a written recommendation for resolution to the University President for final administrative decision. Any recommendation made by the Board or the President must be consistent with current intellectual property law and collective bargaining agreements.

The Board shall meet at least once a year, preferably in Fall semester. At the meeting, the Dean of Office of Research, Economic and Community Development will provide a written report of the intellectual property activities in which the University has been involved in the prior academic year, including a summary statement of income and expenses from intellectual property in which the University has an interest and an accounting of income and disbursements of a dedicated fund (see Section IV.B).

### **3. University Assistance.**

The protection and commercialization of intellectual property requires close attention to relevant laws. For example, for a patentable invention, one must carefully and properly document all activities involved in developing the invention from conception to reduction to practice. In addition, there are reasons to preserve secrecy for certain time periods so that the invention can be adequately protected. These considerations often run counter to the typical academic approach of quickly sharing knowledge in the form of presentations at professional meetings and publications in scholarly journals.

Even when the University does not own intellectual property under this policy, or enjoy an equity interest in it, the [Office of Research, Economic and Community Development](#) can provide guidance to [members of the University community](#) about the basic process for, and issues regarding, protection of intellectual property. Further, under certain circumstances in which the University holds an equity interest, legal, financial and business assistance may be provided to faculty who wish to protect or commercialize their intellectual property. The University's decision to provide such assistance would be made on a case-by-case basis. When the [University/Sponsored Programs](#) Foundation provides legal, financial, business and/or other extraordinary services to support intellectual property interests, they are entitled to recoup expenditures from-gross proceeds derived from those intellectual property interests that are successfully commercialized.



#### **4. Inactivity.**

If a determination has been made that the University owns or has an equity interest under this policy in a particular intellectual property, a decision to pursue protection and commercialization of that property normally will be made within six months of a request by the inventor/creator for such a decision. If the University decides to pursue protection and commercialization, it must then act diligently in this regard. If the University fails to act diligently, the inventor/creator may request reconsideration of the decision to pursue. Alternatively, if the University determines not to pursue protection/development of the intellectual property, it will renegotiate its ownership and/or equity rights with the creator/inventor.

### **B. The Sponsored Programs Foundation (SPF)**

The Humboldt State University Sponsored Programs Foundation ([SPF](#)) is a non-profit, public benefit corporation serving as a qualified auxiliary organization in support of the University. The [SPF](#) functions in several roles relating to the perfection, protection, transfer and development of intellectual property held by the faculty, students, staff, or the University. Among these are:

#### **1. Perfection of Rights.**

The perfection of legal and equity interest in intellectual property generally involves exacting documentation and compliance with statutory and regulatory procedures. The [Sponsored Programs Foundation](#) typically acts as the contracting agency for externally sponsored research and development projects on behalf of the University and the principal investigator. Sponsored agreements may have specific invention or creation disclosure requirements and patent/copyright and licensing provisions requiring compliance through the [SPF](#).

#### **2. Protection.**

At the request of the Dean of [Research, Economic and Community Development](#), or in satisfaction of sponsored agreement requirements, the [Sponsored Programs Foundation](#) shall initiate action to further evaluate the need for and practicality of securing appropriate statutory protection over any intellectual property subject to this policy. Results of any such evaluations shall be reported to that Dean and the inventor or creator.

#### **3. Transfer and Development.**

At the request of the University, the [Sponsored Programs Foundation](#) may serve as the transfer and development agent for those with legal and/or equity rights to intellectual property under this policy. Actions to evaluate protection typically also involve the assessment of commercial viability, and may require the [SPF](#) to negotiate among the interested parties appropriate assignment and collateral agreements to settle those interests and obligations, and to assure property protection and development opportunities. In its role as agent, the [SPF](#) will involve both the inventor/creator and the University (through the Dean of [Research, Economic and Community Development](#)) in all negotiations with potential buyers or licensors.

#### **4. Fiscal Agent.**

The [Sponsored Programs](#) Foundation also serves as the designated fiscal agent of the University in the administration of transactions involving University interests in such intellectual property. In providing the above services the [SPF](#) shall be entitled to recover its direct costs.

### **C. The Creator/Inventor.**

#### **1. Required Disclosures.**

This policy addresses circumstances in which the University owns intellectual property created by faculty, staff and students, or enjoys an equity interest in it. When these circumstances exist, the faculty, staff or students who create the intellectual property shall file a disclosure statement with the Dean of [Research, Economic and Community Development](#) (see [Section II.C.2](#)). At the appropriate time, that Dean may refer the disclosure to the Advisory Board for Research and Creative Activities, which will assess rights of all interested parties consistent with other sections of this policy. [Disclosures of intellectual property having real or potential as inventions, discoveries, innovations or proprietary information shall be treated by all parties as confidential to the extent legally possible.](#)

#### **2. Protection and Commercialization.**

When the University owns, or enjoys an equity interest in, intellectual property under this policy, and has elected to pursue protection and commercialization of that intellectual property, the inventor/creator is expected to cooperate with the University and [Sponsored Programs Foundation](#) (at the University/ [SPF's](#) expense) in the protection and development of the intellectual property including executing appropriate written instruments to perfect legal and equity rights. It is anticipated that the inventor/creator, if he/she so chooses, will be an active participant in decisions regarding the further development, commercialization and/or licensing of the intellectual property

### **D. Assignments of Interest.**

Any transfers of ownership between those with any interest in specific intellectual property shall be documented through appropriate legal instruments, such as assignment agreements, in a form consistent with applicable law and regulations.

## **IV. INCOME ALLOCATIONS**

### **A. General Objectives.**

In the transfer of intellectual property and allocation of net proceeds derived from intellectual property, the general objectives are to direct funds toward the inventor(s)/creator(s), assure the transfer and development of these discoveries for the public benefit, and provide for the funding of future creative effort by University faculty, students and staff.

### **B. Intellectual Property Funds.**

When the University owns intellectual property or enjoys an equity interest in it, the University's share of net proceeds derived from that intellectual property generally will be allocated among the inventor's college (25 percent), department (25 percent), and University division (25 percent) (Office for Academic Affairs or other University division) and the Sponsored Programs Foundation (25 percent). [Consistent with the definition of "net proceeds" in section I.E.12., the net proceeds shall be determined after costs related to establishing the intellectual property claim incurred by the Principal Investigator, University and/or Sponsored Programs Foundation have been deducted from](#)

the gross proceeds. The net proceeds funds are to be used to support research or scholarly activity, technology transfer, and administrative activities and overhead expenses associated with research, development and protection of intellectual property, and technology transfer.